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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,715

01/06/2004

Karen Aviles

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FITZPATRICK CELLA (AMEX)

30 ROCKEFELLER PLAZA

NEW YORK, NY 10112

EXAMINER

LONG, FONYA M

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,715	<b>Applicant(s)</b> AVILES ET AL.	
	<b>Examiner</b> FONYA LONG	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/06/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-20, as originally filed, are currently pending and have been considered below.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a “manufacture” nor a “process,” but rather embrace or overlap two different statutory classes of invention. The claims are directed to both an apparatus and a method. The claim recites a “donation engine” but the claim limitations refer to a method. “A claim of this type is precluded by the express language of 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.” See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are directed to an apparatus (i.e. a donation engine) wherein the claim limitations are directed to a method. The claims do not recite any structural language but rather recite the method steps. It is unclear whether the apparatus is being claimed or the method.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by DonationDepot.com (October 08, 2001).

As per Claims 1, 2, 4-7, and 9, DonationDepot.com discloses a donation engine and method, which is located in an online environment (via DonationDepot.com website) that is configured to facilitate:

providing access to all government approved 501(c) charities (Pages 1 and 3, discloses the system being provided for all donors and all US 501(c) 3 non-profit organizations, wherein a list of all registered non-profit organizations in the United States are provided to the donors) via a donation portal (defined as a site serving as a

guide or point of entry to the World Wide Web and usually including a search engine or a collection of links to other sites arranged especially by topic in *Merriam-Webster Online Dictionary*. Retrieved July 17, 2008, from <http://www.merriawebster.com/dictionary/portal>) (Pages 1-10, discloses providing a search engine on the website where a donor may search for a charity; and providing a hyperlink to obtain additional information about a charity via "Featured Charity");

searching for at least one of said charities (Page 1, discloses a donor capable of searching for a charity via "Find a Charity"); and

receiving donation information including recurring billing information (Page 2, discloses receiving automatic payroll deduction information (i.e. recurring billing)), donor information (Page 5, discloses the donor providing personal information such as name, address, and phone), donation amount (Page 6, discloses the donor providing the amount to be donated), and gift matching information (Pages 4 and 6, discloses the donor providing company gift matching information).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 8, and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DonationDepot.com (October 08, 2001) in view of Chien et al. (US 2001/0054003).

**As per Claims 3 and 8**, DonationDepot.com discloses the claimed invention as applied to Claim 1, above. However, DonationDepot.com fails to explicitly disclose loyalty points being used as a charitable donation.

Chien et al. discloses a system and method of using loyalty points with the concept of loyalty points being used as a charitable donation ([0012] discloses a user redeeming or converting loyalty points for charitable donations).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for donating to charitable organizations via online of DonationDepot.com to include loyalty points being used as a charitable donation as taught by Chien et al. in order to provide a non-monetary way for a donor to contribute to a desired charitable organization.

**As per Claims 10-20**, DonationDepot.com discloses a donation method, wherein said method comprising:

accessing at least one of all government approved 501(c) charities (Pages 1 and 3, discloses the system being provided for all donors and all US 501(c) 3 non-profit organizations, wherein a list of all registered non-profit organizations in the United States are provided to the donors) via a donation portal (defined as a site serving as a guide or point of entry to the World Wide Web and usually including a search engine or a collection of links to other sites arranged especially by topic in *Merriam-Webster*

*Online Dictionary*. Retrieved July 17, 2008, from <http://www.merriawebster.com/dictionary/portal>) (Pages 1-10, discloses providing a search engine on the website where a donor may search for a charity; and providing a hyperlink to obtain additional information about a charity via "Featured Charity") by providing at least one list capabilities, searching capabilities, and selecting capabilities (Page 1, discloses a donor being able to search for a charity, or obtain a listing of charities); and

receiving donation information for at least one of said charities, wherein donation information includes donor information (Page 5, discloses the donor providing personal information such as name, address, and phone), donation amount (Page 6, discloses the donor providing the amount to be donated), recurring billing information (Page 2, discloses receiving automatic payroll deduction information (i.e. recurring billing)), and gift matching information (Pages 4 and 6, discloses the donor providing company gift matching information).

However, DonationDepot.com fails to explicitly disclose loyalty points being used as a donation to a charitable organization; and verifying donation information.

Chien et al. discloses a system and method for using loyalty points with the concept of loyalty points being used as a charitable donation ([0012] discloses a user redeeming or converting loyalty points for charitable donations) wherein donation information is verified by communication with at least one third party, said third party including at least one of a financial institution, a charity, a loyalty point issuer, an employer, and a government entity authorized to approve charities ([0010-0011]

discloses an account manager verifying loyalty point information via verifying that sufficient credit is available on participant's financial transaction account and/or sufficient loyalty points are available in participant's loyalty account).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for donating to charitable organizations via online of DonationDepot.com to include loyalty points being used as a donation to a charitable organization and donation information is verified as taught by Chien et al. in order to provide a non-monetary way for a donor to contribute to a desired charitable organization.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shade et al. (6,519,573) discloses a system and method for charitable giving.

Lomangino (US 2002/0052756) discloses a method and apparatus for facilitating donations.

Cohagan et al. (US 2005/0043992) discloses a point pooling loyalty system and method.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./  
Examiner, Art Unit 3689

/Dennis Ruhl/

Primary Examiner, Art Unit 3689

Application/Control Number: 10/707,715  
Art Unit: 3689

Page 9